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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,252	04/21/2004	Daniel M. Schwartz	15832.0018	4854

23517 7590 01/26/2007  
BINGHAM MCCUTCHEN LLP  
3000 K STREET, NW  
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WASHINGTON, DC 20007

EXAMINER
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CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2178

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/828,252	<b>Applicant(s)</b> SCHWARTZ ET AL.	
	<b>Examiner</b> Joshua D. Campbell	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10,15 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,15 and 23-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed on 11/30/2006.
2. Claims 1-4, 6-10,15, and 23-30 are pending in this case. Claims 1 and 15 are independent claims. Claims 1 and 15 have been amended.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1-4, 6-10,15, and 23-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 and 15 now state "...electronically laying out during design of a digital magazine a plurality of pages to form the digital magazine, such that each page fully fits a selected on of either a landscape format or a portrait format display screen," which does not appear to be enabled by the specification. The specification does not state that during the design of the magazine each page will fully fit the display screen in either portrait or landscape, rather the specification states, "In step 3-1, the text and graphics, i.e., all the viewable features, of each page of the magazine are designed (laid out) to fill a full display screen in the landscape format, e.g., in a height:width (aspect) ratio of 3:4. Similarly, if a portrait format is desired, the text and graphics are laid out for full-screen viewing in an aspect ratio typical of a portrait-oriented display screen, e.g. 4:3," (page 8, paragraph 0042 of Applicant's Specification). This states that the pages are laid out in what is believed to be the

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typical aspect ratio of the display screens for portrait or landscape viewing, however the specification does not provide any evidence that each page will fully fit a display screen at the time of design. For instance, if the screen used by the use did have the typical aspect ratio of 3:4 or 4:3, which is the case with all widescreen TVs and computer display screens that are 16:9, the pages would not fully fit the display screen. The specification does not discuss actually forcing the page to fully fit a screen until page 10, lines 24-27, in which it states that a Java script function is used to fit the page to the actual width of the display screen being used at the time of viewing, which constitutes fully fitting the page to a display screen. In claim 1 and 15, it also states that limitation, "so that each page is displayable in a full-screen manner," which is believed to be enabled, and thus requires no change. This limitation merely defines that the pages be in a format capable of being viewed in a full-screen manner at some point, which is clearly enabled by the specification.

Proper correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-4, 6-10, 15, and 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCurdy et al. (hereinafter McCurdy, US filing date June 30, 2000) in view of Ayers et al. (hereinafter Ayers, US Patent Number 6,915,484, filed on August 9,

2000) further in view of Adobe Creative Team (hereinafter ACT, "Adobe Acrobat 4.0 Classroom in a Book", second edition, published on January 4, 2000).

**Regarding independent claim 1**, McCurdy discloses a method in which a plurality of pages is laid out to form a digital magazine and the pages are combined to form one single document which can be viewed in landscape or portrait format (page 2, paragraph 0014, page 15, paragraphs 0200 and 0203). Once the digital magazine finished it may be locked from being edited (limited access) and then electronically distributed to a plurality of subscribers (page 13, paragraph 0185 and page 18, paragraph 0272).

McCurdy does not disclose a method in which each page full fits the display screen and thus is displayable in a full-screen manner in both portrait and landscape format. However, Ayers discloses a method in which a PDF document may be reflowed at any time in order to full fit a display, which includes both portrait and landscape displays (column 1, line 58-column 2, line 51 of McCurdy). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of adapting a PDF of McCurdy with the teachings of Ayers because it would have allowed electronic magazines to be catered to any different size displays, for instance full-screen portrait and landscape formats, prior to being stored.

Neither McCurdy nor Ayers disclose the navigation bar is inserted into the pages and stored as a part of the pages and that no other border or toolbar is displayed with the pages. However, ACT discloses that any PDF document when being created, like the PDF documents of McCurdy and Ayers, can be set to be displayed in a full-screen

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manner in which the borders and all toolbars are hidden (pages 19 and 20 of ACT).

ACT also discloses that navigation bars consisting of functional buttons may be added to a PDF document and be saved and stored directly into the document, as part of the document (pages 1-5 of ACT). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of McCurdy and Ayers with the teachings of ACT because it would have allowed users to activate a series of actions from within the document itself and it would have added a new dimension to the level of interactivity in a document (pages 1 and 20 of ACT).

**Regarding dependent claim 2,** McCurdy discloses a method in which the magazine may be transmitted as an attachment to an e-mail message (page 23, paragraph 0348 of McCurdy).

**Regarding dependent claims 3 and 4,** McCurdy discloses a method in which the magazine may be stored at URL that is linked to in order to download (paragraph 0348 of McCurdy). McCurdy does not explicitly say that the URL would be emailed to users to access the document. However, McCurdy does disclose that subscriber may wish to be e-mailed when a new issue is available and since that issue may be accessed using a link to a URL (website), as disclosed by McCurdy (page 13, paragraph 0185 and page 23, paragraph 0348 of McCurdy), it would have been obvious to one of ordinary skill in the art at the time the invention was made that the URL link itself would have been e-mailed to the user because it would have required less data to have been transmitted in the e-mail message as opposed to transmitting the entire document.

**Regarding dependent claims 6 and 7,** McCurdy discloses a method in which the display screen may show the magazine in portrait format or be rotated to show it in landscape format (pages 14-15, paragraphs 0199-0200 of McCurdy).

**Regarding dependent claim 8,** McCurdy discloses a method in which an audio or video clip may be programmed into the digital magazine (page 2, paragraph 0011 of McCurdy).

**Regarding dependent claims 9 and 10,** McCurdy discloses a method in which a template is used to lay out the areas of the pages and that the document is stored in a compressed Portable Document Format (page 2, paragraph 0018 and page 24, paragraph 0372 of McCurdy).

**Regarding independent claim 15,** McCurdy discloses a method in which the magazine may be transmitted as an attachment to an e-mail message (page 23, paragraph 0348 of McCurdy). McCurdy discloses a method in which a plurality of pages is laid out to form a digital magazine and the pages are combined to form one single document which can be viewed in landscape or portrait format (page 2, paragraph 0014, page 15, paragraphs 0200 and 0203). Once the digital magazine finished it may be locked from being edited (limited access) and then electronically distributed to a plurality of subscribers (page 13, paragraph 0185 and page 18, paragraph 0272).

McCurdy does not disclose a method in which each page full fits the display screen and thus is displayable in a full-screen manner in both portrait and landscape format. However, Ayers discloses a method in which a PDF document may be reflowed

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at any time in order to full fit a display, which includes both portrait and landscape displays (column 1, line 58-column 2, line 51 of McCurdy). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of adapting a PDF of McCurdy with the teachings of Ayers because it would have allowed electronic magazines to be catered to any different size displays, for instance full-screen portrait and landscape formats, prior to being stored.

Neither McCurdy nor Ayers disclose the navigation bar is inserted into the pages and stored as a part of the pages and that no other border or toolbar is displayed with the pages. However, ACT discloses that any PDF document when being created, like the PDF documents of McCurdy and Ayers, can be set to be displayed in a full-screen manner in which the borders and all toolbars are hidden (pages 19 and 20 of ACT). ACT also discloses that navigation bars consisting of functional buttons may be added to a PDF document and be saved and stored directly into the document, as part of the document (pages 1-5 of ACT). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of McCurdy and Ayers with the teachings of ACT because it would have allowed users to activate a series of actions from within the document itself and it would have added a new dimension to the level of interactivity in a document (pages 1 and 20 of ACT).

**Regarding dependent claims 23-30**, the claims incorporate substantially similar subject matter as claims 2-4 and 6-10. Thus, the claims are rejected along the same rationale as claims 2-4 and 6-10.



***Response to Arguments***

6. Applicant's arguments filed 11/30/2006 have been fully considered but they are not persuasive. First, the examiner does not believe the amendments to the claim are fully supported and enabled by the specification as explained above. Second, even if the amendment was enabled the rejection as previously presented clearly renders the limitations as claimed obvious. For instance, in the previous rejection the examiner stated, **"Ayers discloses a method in which a PDF document may be reflowed in order to full fit a display, which includes both portrait and landscape displays** (column 1, line 58-column 2, line 51 of McCurdy). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of adapting a PDF of McCurdy with the teachings of Ayers because it would have allowed electronic magazines to be catered to any different size displays, for instance full-screen portrait and landscape formats, prior to being stored," (emphasis added) in addition to this the examiner also stated, **ACT discloses that any PDF document when being created, like the PDF documents of McCurdy and Ayers, can be set to be displayed in a full-screen manner in which the borders and all toolbars are hidden** (pages 19 and 20 of ACT). ACT also discloses that navigation bars consisting of functional buttons may be added to a PDF document and be saved and stored directly into the document, as part of the document (pages 1-5 of ACT). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of McCurdy and Ayers with the teachings of ACT because it would have allowed users to activate a series of actions from within the

document itself and it would have added a new dimension to the level of interactivity in a document (pages 1 and 20 of ACT)," (emphasis added). The teachings of these two references in combination with the teachings of McCurdy clearly render the claimed invention obvious, and motivation to combine the references was clearly provided in the previous rejection.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

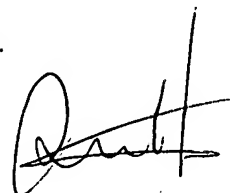
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JDC  
January 10, 2007



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SUPERVISORY PATENT EXAMINER